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	APPLICATION NO.	F	ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/781,316		02/17/2004		Takashi Suzuki	01201D/HG	4866	
	1933	1933 7590 04/11/2006			EXAMINER		
	FRISHAUF, HOLTZ, GOODMAN & CHICK, PC				FIGUEROA, JOHN J		
	220 Fifth Ave 16TH Floor	nue			ART UNIT	PAPER NUMBER	
	NEW YORK.	NY 10	0001-7708		1712		

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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		Application No.	Applicant(s)	
		10/781,316	SUZUKI ET AL.	
	Office Action Summary	Examiner	Art Unit	
		John J. Figueroa	1712	
Period fo	The MAILING DATE of this communication app or Reply	pears on the cover sheet with the c	orrespondence address	
	ORTENED STATUTORY PERIOD FOR REPLY	VIS SET TO EXPIRE 1 MONTH	(S) OR THIRTY (30) DAYS	
WHIC - Exte after - If NC - Failu · Any	CHEVER IS LONGER, FROM THE MAILING DANSIONS of time may be available under the provisions of 37 CFR 1.1: SIX (6) MONTHS from the mailing date of this communication. O period for reply is specified above, the maximum statutory period were to reply within the set or extended period for reply will, by statute reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tir will apply and will expire SIX (6) MONTHS from , cause the application to become ABANDONE	N. nely filed the mailing date of this communication. ED (35 U.S.C. § 133).	
Status				
1)⊠	Responsive to communication(s) filed on Febru	uary 17, 2004.		
2a)□	This action is <b>FINAL</b> . 2b)⊠ This	action is non-final.	•	
3)	Since this application is in condition for allowar	nce except for formal matters, pro	osecution as to the merits is	
	closed in accordance with the practice under E	Ex parte Quayle, 1935 C.D. 11, 49	53 O.G. 213.	
Dispositi	ion of Claims			
4)	Claim(s) <u>1-24</u> is/are pending in the application.			
	4a) Of the above claim(s) is/are withdray			
5)	Claim(s) is/are allowed.			
6)	Claim(s) is/are rejected.		•	
7)	Claim(s) is/are objected to.	•	•	
8)⊠	Claim(s) <u>1-24</u> are subject to restriction and/or e	election requirement.		
Applicati	ion Papers	•		
9)	The specification is objected to by the Examine	·г.		
•—	The drawing(s) filed on is/are: a) acc		Examiner.	
•—	Applicant may not request that any objection to the			
	Replacement drawing sheet(s) including the correct	ion is required if the drawing(s) is ob	jected to. See 37 CFR 1.121(d).	
11)	The oath or declaration is objected to by the Ex	caminer. Note the attached Office	Action or form PTO-152.	
Priority ι	under 35 U.S.C. § 119		*	
12)	Acknowledgment is made of a claim for foreign	priority under 35 U.S.C. § 119(a	)-(d) or (f).	
	☐ All b)☐ Some * c)☐ None of:			
	1. Certified copies of the priority document	s have been received.	·	
	2. Certified copies of the priority document	s have been received in Applicat	ion No	
	3. Copies of the certified copies of the prior		ed in this National Stage	
	application from the International Bureau	• • • • • • • • • • • • • • • • • • • •	-,	
* \$	See the attached detailed Office action for a list	of the certified copies not receive	<b>∌d</b> .	
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ø				
Attachmen		40 M 1-4 10 - 10 - 10 - 10 - 10 - 10 - 10	· (DTO 442)	
	ce of References Cited (PTO-892) te of Draftsperson's Patent Drawing Review (PTO-948)	4) 🔀 Interview Summary Paper No(s)/Mail D		
3) 🔲 Infon	mation Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	·	Patent Application (PTO-152)	
Pape	er No(s)/Mail Date	6)		

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## **DETAILED ACTION**

## Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - Claims 1-5, drawn to adhesive sheet, classified in class 428, subclass 355
     AC.
  - II. Claims 6-16, drawn to an adhesive optical component having an optical component and am layer of an adhesive composition comprising a methacrylic ester copolymer, a crosslinking agent and a phenol compound, classified in class 428, subclass 500+.
  - III. Claims 17-24, drawn to an adhesive optical component having an optical component and am layer of an adhesive composition comprising a methacrylic ester copolymer, a crosslinking agent and a radical scavenger, classified in class 351, subclass 159+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

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In the instant case, the combination in Invention II as claimed does not require the particulars of the subcombination as claimed because the subcombination (adhesive sheet) contains an adhesive composition that is coated on an *acetyl cellulose* substrate, whereas the adhesive composition in the optical component need not be coated on a acetyl cellulose substrate.

The subcombination has separate utility such as an intermediate adhesive layer component of a multilayered tape with a release layer and a protective substrate layer.

3. Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination in Invention III as claimed does not require the particulars of the subcombination as claimed because the subcombination (adhesive sheet) comprises an adhesive composition containing a methacrylate copolymer; a crosslinking agent; and a phenol compound, whereas the adhesive composition in the optical component does not require a phenol compound but instead requires a radical scavenger.

The subcombination has separate utility such as an intermediate adhesive layer component of a multilayered tape with a release layer and a protective substrate layer.

4. Inventions II and III are directed to adhesive optical components. The inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually

exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j).

In the instant case, the adhesive optical components comprise distinct adhesive compositions. The adhesive composition of the adhesive optical component of Invention II is limited by the claims to comprise a methacrylate copolymer, a crosslinking agent and a phenol compound.

On the other hand, the adhesive composition of the adhesive optical component of Invention III comprises a methacrylate copolymer (or a mixture thereof with an oligomer of methacrylic esters) having a specified molecular weight, a crosslinking agent and a radical scavenger.

- 5. Because these inventions are independent or distinct for the reasons given above, have acquired a separate status in the art because of their recognized divergent subject matter and require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.
- 6. A telephone call was made to Mr. Richard S. Barth on March 29, 2006 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103 (a) of the other invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

## Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Mon-Thurs & alt. Fri 8:00-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JJF/RAG

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